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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/058,766	06/05/87	HESEL	L

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EXAMINER	
COSTANTINO, M	
ART UNIT	PAPER NUMBER
336	14

DATE MAILED:

11/20/87

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 10/21/87 ☐ This action is made final.

(three) 3

A shortened statutory period for response to this action is set to expire month(s), days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 15, 19, 20 are pending in the application.

Of the above, claims are withdrawn from consideration.

2. ☐ Claims have been cancelled.

3. ☐ Claims are allowed.

4. ☒ Claims 15, 19, 20 are rejected.

5. ☐ Claims are objected to.

6. ☐ Claims are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.

8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on . These drawings are ☐ acceptable;
☐ not acceptable (see explanation).

10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed , has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

12. ☒ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☒ been received ☐ not been received
☐ been filed in parent application, serial no. ; filed on .

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

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Claims 15, 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15 and 19 are indefinite in that the terminology "adapted for radially stretching" "does not claim sufficient structure to support the function claimed, i.e. it is unclear how the second ring could stretch the closed end of the sheath without it having a diameter larger than the sheath diameter. Claims 15 and 19 are incomplete in that the "second elastic ring" or "second outwardly ring-shaped means" is not attached to or associated with the sheath. The second ring should at least be - removably attached - to the closed end of the sheath.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Adams '541.

Note sheath 12, first ring 10, and "second ring means" 28. The vent apertures 18 of Adams are optional (see column 2, lines 44-51). The language of claim 19 that the sheath is "sufficiently large to permit movement..." is functional and without defining any spe

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cific size does not further limit the structure claimed.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 15, 19 and 20 are rejected under 35 U.S.C. 103 as being unpatentable over "The Bee Gee Company" brochure in view of Graham.

"The Bee, Gee Company " brochure teaches that it is well known to provide an oversized tubular sheath having open and closed ends and a first resilient ring which is of larger diameter than the sheath. The sheath of "Bee Gee" is maintained within a female.

Graham teaches placing a resilient ring 1, within a tubular semen collecting sheath to maintain the sheath within a female.

It would have been obvious to one of ordinary skill in the art to place a resilient ring in the closed end of the sheath of "Bee Gee" to maintain the sheath in place within a female in view of Graham.

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Note also German Patent 210,413 which appears to show a female insertable sheath having a widened open end.

Any inquiry concerning this communication should be directed to Mario Costantino at telephone number 703 557-3125.

COSTANTINO:jf

11 10-87 *ml.*


C. FRED ROSENBAUM
S. P. E.
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